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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,855	04/12/2001	Wanqian D. Liu	20683000110	8400
20350	7590	05/09/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/834,855	Applicant(s) LIU ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/25/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

*PD*

### DETAILED ACTION

1. Claims 1-21 are presented for examination.

#### Objections

2. The abstract of the disclosure is objected to because, the abstract is partially in the claim format. Correction is required. See MPEP § 608.01(b).

#### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-20 are rejected under 102(e) as being anticipated Barnett et al (6,336,099 hereinafter Barnett).

In reference to claim 1, Barnett discloses a method for promoting products with a central server over a computer network comprising of: receiving a specification of a promotion for a product from a first computer (col. 6 lines 55-58, col. 8 lines 14-21, and Figure 9), creating an electronic incentive in response to the specification (col. 8 lines 17-21); transferring the electronic incentive to an application server across the computer network, the application server (i.e. equivalent to the online service provider in the prior art), coupled to a merchant server (i.e. equivalent to the coupon distributor in the prior art), (col. 8

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lines 6-13 and Figure 6); receiving usage data of the electronic incentive from the application server, the usage data determined in response to a promotion usage condition indicated by the merchant server (col. 7 lines 36-41, col. 10 lines 51-56, and Figure 1); generating a report in response to the usage data (col. 7 lines 44-51); wherein data associated with the electronic incentive is transferred from the application server to the merchant server (Figure 1); wherein the merchant server specifies rendering of the data associated with the electronic incentive (col. 7 lines 36-55).; and wherein the promotion usage condition is indicated in the merchant server when a user coupled thereto fulfills requirements of the electronic incentive (col. 7 lines 17-20).

4. In reference to claim 8, Barnett teaches a method for a merchant server coupled to a client system comprising: requesting promotions from an application server coupled to the merchant server (Figure 1); receiving a description of a promotion from the application server (Figure 3), the description including pre-conditions and a user benefit; determining an output representation of the promotion in response to the description of the promotion and (Figure 3 and Figure 5); thereafter transmitting the output representation of the description to a client system for display to a user (col. 8 lines 22-33 and Figure 1); receiving a selection of at least one item from the client system (col. 9 lines 59-67); transmitting the selection of the at least one item to the application server (col. 10 lines 1-16); when the application server determines that the selection of the at least one item fulfills the pre-conditions, receiving an indication that the user is provided with the user benefit from the application server (col. 7 lines 35-44 and

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col. 10 lines 47-53); and thereafter storing in a log a record that the user is provided with the user benefit (col. 10 lines 51-56).

5. In reference to claims 2 and 9, Barnett teaches a class of electronic incentives comprising of: cents off (Figure 5), percent discount, price point, buy X get Y free (col. 12 lines 45-54), solution selling, and promotion content.

6. In reference to claims 3 and 10, Barnett teaches an electronic incentive comprising a delivery method selected from the group or class including: non-targeted, targeted category (col. 6 lines 62-65), targeted usage (col. 6 lines 62-65), targeted brand, and targeted market (col. 7 lines 45-51, col. 4 lines 36-40, and Figure 9).

7. In reference to claims 4 and 5, Barnett teaches the electronic incentive comprising a tracking code (col. 7 lines 21-35 and Figure 3) and calendar data selected from the group: effective date, expiration date (Figure 3)

8. In reference to claim 6, Barnett teaches the electronic incentive comprising a network computer address (col. 13 lines 58-67 and Figure 4A).

9. In reference to claim 7, Barnett teaches a method wherein the usage from the application server comprises data selected from the group: demographic data of the user (col. 6 lines 58-62 and col. 7 lines 62 to col. 8 lines 1), a geographic indicator of the user, a number of products purchased by the user, currency value of products purchased by the user, a list of products purchased by the user (col. 8 lines 17 to 21), the tracking code (col. 7 lines 21-35 and Figure 3).

10. In reference to claim 11, Barnett teaches the method wherein the pre-conditions are selected from the class: purchase of an item (col. 12 lines 8-52,

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col. 13 lines 33-38, and Figure 5), purchase of a quantity of an item (Figure 5), purchase of at least two different items (Figure 3).

11. In reference to claim 12, Barnett teaches a method wherein requesting promotions from the application server comprises: determining a category of items for display for the client system (col. 8 lines 14-21 and Figure 10); and requesting promotions from the application server in response to the category of items (col. 8 lines 22-32 and Figure 1).

12. In reference to claim 13, Barnett teaches a method further comprising transmitting a plurality of items to the client system for display (col. 9 lines 34-45); wherein requesting promotions from the application server comprises requesting promotions from the application server in response to the plurality of items (col. 8 lines 22-32 and Figure 1).

13. In reference to claim 14, Barnett teaches a method further comprising receiving a selection of a trigger item from the client system (col. 12 lines 48-52); and wherein requesting promotions from the application comprises requesting promotions from the application server in response to the trigger item (col. 12 lines 41-60).

14. In reference to claim 15, Barnett teaches method for an application server comprises: receiving an electronic incentive from a central server, the electronic incentive including a pre-condition and a benefit (Figure 3); receiving a request from a merchant server for electronic incentives (Figure 1); providing a description of the electronic incentive to the merchant server in response to the request, the description including a description of the pre-condition and the

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benefit (Figure 1); determining whether the selection of the one item fulfills the pre-condition (col. 7 lines 12-17); when the selection of the one item fulfills the pre-condition, providing the merchant server with the benefit (col. 7 lines 41-45); receiving from the merchant server a selection by a user of at least one item (col. 9 lines 59-67); and when the selection of the one item fulfills the pre-condition (col. 7 lines 35-44 and col. 10 lines 47-53), recording that the electronic incentive has been used (col. 10 lines 51-56).

15. In reference to claim 16, Barnett teaches a method wherein the request from the merchant server also includes a description of a shopping category of a user (col. 12 lines 41-60 and Figure 10).

16. In reference to claim 17 Barnett teaches a method wherein the request from the merchant server also includes an indicator of items previously selected by the user or currently displayed to user (col. 12 lines 48-54).

17. In reference to claim 18, Barnett teaches a method wherein the pre-condition comprises purchase of the one item (col. 12 lines 8-52, col. 13 lines 33-38, and Figure 5).

18. In reference to claim 19, Barnett teaches a method wherein the request from the merchant server also includes an identifier of the user (col. 7 lines 21-34).

19. In reference to claim 20, Barnett teaches the method further comprising forwarding the recording that the electronic incentive has been used to a centralized server (col. 7 lines 36-55).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 21 is rejected under U.S.C. 103(a) as being unpatentable over Barnett et al. in view of official notice. In reference to claim 21, official notice is taken that it is old and well known to co-locate two servers, since this would involve using less cable for the connection of the two servers and would hence be more cost effective. Furthermore, co-locating the application and merchant servers does not alter the steps that are performed with the two servers when they are not co-located. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include co-location of the application server and the merchant serve to obtain the above-mentioned advantage.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686



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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.09/834,851. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims recite a method for promoting products using a world wide web and copending application number 09/834,851 claims recite a system for promoting products using the world wide web. It is obvious that a system is required to carry out the method as recited in 09/834,855, and a recitation of such a required system does not does not make the claims of the present application patentable distinct over the claims of the above mentioned copending patent application. Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to conceive of and include a system with the method

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for promoting products using a world wide web as recited in this application in order to implement the recited method.

**Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Barnett Patent Number 6,336,099. Teaches a method and system for electronic distribution of product redemption coupons.
- b) Blinn Patent Number 5,999,914. Teaches the use of an electronic promotion system for an electronic merchant system.
- c) Linden Patent Number 6,266,649. Teaches collaborative recommendations using item-to-item similarity mappings.
- d) Sloane Patent Number 5,918,211. Teaches the use of a wireless hand-held scanner for making purchases at a retail store that issues on the spot promotions as items are scanned.
- e) Yamashita Patent Number 6,360,206. Teaches an electronic shopping system where the discount coupons are provided via the Internet, e-mail, or a CD-ROM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

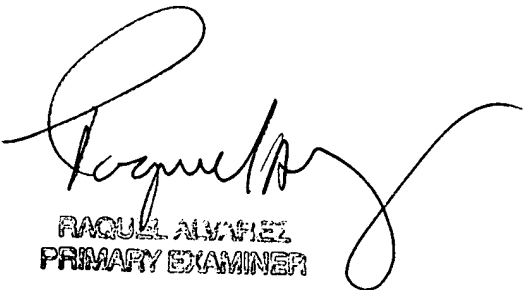
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examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

April 18, 2005



RAQUEL ALVAREZ  
PRIMARY EXAMINER